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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,443	03/22/2001	David G. Angeley	P-4285-US	8017

7590 06/16/2003  
Eitan, Pearl, Latzer & Cohen, Zedek, LLP  
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Suite 1001  
New York, NY 10020

EXAMINER

JEFFERY, JOHN A

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/814,443

Applicant(s)

ANGELEY ET AL.

Examiner

John A. Jeffery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Renumbering of Claims***

Pursuant to 37 CFR 1.126, the original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

Accordingly, claim 20 (second occurrence) has been renumbered as claim 21.

### ***Acknowledgment of Election Without Traverse***

Applicant's election without traverse of Group I, claims 1-19 in Paper No. 11 is acknowledged. Accordingly, claims 20 and 21 are withdrawn from consideration as being directed to a nonelected invention.

### ***Claim Objections***

Claims 11-15 are objected to because of the following informalities:

Claim 15: In line 13, "there" must be changed to "thereof."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7-9, 16, 17, and 19 are rejected under 35 USC 102(b) as being anticipated by Nanaumi (US4653495). Nanaumi (US4653495) discloses a method of delivering laser energy to tissue comprising providing a plurality of polygonal lightguides 19 and a scanning unit 13 such that the output image from the exit-face of the lightguide uniformly irradiates the tissue. See col. 5, lines 10-55 and col. 6, line 54 - col. 7, line 58. See also Figs. 6, 8, and 9. Regarding claim 3, although not expressly stated in Nanaumi (US4653495), in view of the substantial relative spacing of the square fibers in the array as shown in Fig. 9, the light exiting the individual fibers would inherently not overlap. With regard to claim 19, note col. 7, lines 33-38 in which Nanaumi (US4653495) teaches changing the sequence in which the square optical fibers are radiated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 4, 6, 10-12, 14, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanaumi (US4653495) in view of Buys et al (US5336217). The claims differ from the previously cited prior art in calling for a plurality of lenses and moving the treatment spot via relative movement between the exit-face of the lightguide and at least one lens. Providing a plurality of lenses and moving a fiber relative thereto is conventional and well known in the art as evidenced by Buys et al (US5336217) noting means for moving the optical fiber 9 relative to the lenses 12, 13 so that the treatment spot is moved. See col. 14, lines 28-38. In view of Buys et al (US5336217), it would have been obvious to one of ordinary skill in the art to move the treatment spot by moving the fiber in the previously described apparatus so that the a larger tissue treatment region was more uniformly irradiated. Regarding claim 4, although Nanaumi (US4653495) does not disclose a rectangular or hexagonal cross-section, the reference in col. 7, lines 47-51 teaches that one of ordinary skill in the art can select a variety of polygonal fiber cross sections to match the desired pattern. Therefore, the specific cross section geometry is a matter of engineering design preference and do not constitute a patentably distinguishable feature of the invention. Regarding claim 6, no criticality is seen in the fiber length being less than 50mm; the selection of fiber length is therefore not a patentable feature of the invention. Regarding claim 10, although Nanaumi (US4653495) does not expressly quantify the precise level of uniformity, the

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reference however teaches the desirability of a uniform irradiation of laser energy onto the tissue. Moreover, no criticality is seen in the uniformity values claimed and the values do not therefore constitute a patentably distinguishable feature of the invention.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nanaumi (US4653495) in view of Buys et al (US5336217) and further in view of Trost (US5743902). The claims differ from the previously cited prior art in calling for treatment spot moving to be via a galvanometer mirror arrangement. However, the use of galvanometer mirror arrangements to move treatment spots in tissue irradiation apparatus is conventional and well known in the art as evidenced by Trost (US5743902) noting col. 5, lines 10-27 wherein galvanometers 66, 70 cause mirrors attached thereto to rotate to assist in laser scanning. In view of Trost (US5743902), it would have been obvious to one of ordinary skill in the art to provide a galvanometer mirror arrangement to assist in scanning the laser beam of the previously described apparatus so that a two-dimensional pattern can be achieved.

#### ***Other Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art should be both separately considered and considered in conjunction with the previously cited prior art when responding to this action.

WO '984, US 699 (Figs. 7-8a), US 416, US 710, US 963, US 615, JP 453, JP 120, US 734 disclose irradiation apparatus relevant to the instant invention.

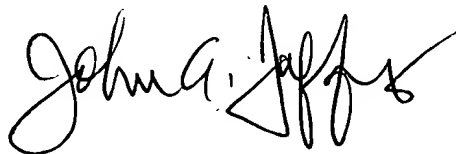
***Conclusion***

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 305-3463. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM EST. The examiner can also be reached on alternate Fridays.

The fax phone numbers for the organization where this application or proceeding is assigned are:

Before Final	(703) 872-9302
After Final	(703) 872-9303
Customer Service	(703) 872-9301

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0861.



**JOHN A. JEFFERY  
PRIMARY EXAMINER**

**6/6/03**